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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,769	01/30/2004	Hidehiko Ogawa	P24501	5549

7055 7590 09/29/2005

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,769	Applicant(s) OGAWA, HIDEHIKO	
	Examiner Thomas D. Lee	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/461,402.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/1/04, 7/6/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☒ Notice of Informal Patent Application (PTO-152)
- ✓ 6) ☒ Other: IDS filed 3/4/05.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.

09/461,402, filed on December 15, 1999. **Specification**

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-15, 21-26, 29-34 and 37-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,710,894 (Ogawa) in view of U.S. Patent 6,885,470 (Toyoda et al., hereinafter Toyoda) and U.S. Patent 5,878,230 (Weber et al., hereinafter Weber).

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Although the conflicting claims are not identical, they are not patentably distinct from each other. The panel section in the application is configured to input information regarding an identification of a user and a mail address of a user to the image communication apparatus while the panel section in the patent is configured to select information regarding the identification of the user in a memory, which stores user identification information. In the application, a mail address of the user, as well as information regarding an identification of a user, is set into the mail message of an e-mail to which image data is attached. This limitation is disclosed in Toyoda (e-mail message includes sender ID (toyoda) and source address (toyoda @mei.co.jp) (Fig. 17)). Providing a user's mail address and identification information, as disclosed in Toyoda, enables a person at the receiving apparatus to identify the person sending the e-mail message, in the case where a number of people are associated with the same e-mail address. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Ogawa by providing for input of user identification and a user mail address, such as disclosed in Toyoda.

The claims in the application further recite utilization of the mail address of the user set into the mail message of the e-mail as a destination of a reply to the e-mail (claims 1, 22, 29 and 37), or sending a reply to the e-mail to the user without requiring input of the mail address of the user at the receiving apparatus (claims 6, 23, 31 and 39), or returning a reply to the e-mail to the mail address of the user (claims 11, 25, 33 and 41). These limitations are disclosed in Weber (in known prior art system, a reply attribute is automatically generated, directing a reply to the sender or originator (column

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3, lines 21-27)). Thus a person receiving an e-mail message need not enter the sender's e-mail address in the "to" field when replying to a message to the sender, thereby eliminating the possibility of entering the sender's address incorrectly. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Ogawa and Toyoda by providing automatic reply attribute generation, as disclosed in Weber.

Moreover, pending claims 21, 23, 25, 37, 39 and 41 further recite a transmitter (claims 21, 23, 25) and corresponding transmission step (claims 37, 39, 41), which reads on lines 2-6 of patent claim 1 and lines 3-4 of patent claim 5, respectively.

Furthermore, with regard to claims 5, 10, 15, 22, 24, 26, 30, 32, 34, 38, 40 and 42, it is inherent that image data attachments to e-mail messages are converted into a format for e-mail transmission, as such attachments cannot be transmitted via e-mail otherwise.

5. Claims 16-20, 27, 28, 35, 36, 43 and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of Ogawa in view of Toyoda. Although the conflicting claims are not identical, they are not patentably distinct from each other. As mentioned above, the panel section in the application is configured to input information regarding an identification of a user and a mail address of a user to the image communication apparatus while the panel section in the patent is configured to select information regarding the identification of the user in a memory, which stores user identification information. In the application, a mail address of the user, as well as information regarding an identification of a user, is set into the

mail message of an e-mail to which image data is attached. This limitation, as mentioned above, is disclosed by Toyoda. Also, the above claims in the application omit the limitation, "whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user." The remaining limitations recited in the claims of the application read on the claims of the Ogawa patent. Moreover, pending claims 27 and 43 further recite a transmitter (claim 27) and corresponding transmission step (claim 33), which reads on lines 2-6 of patent claim 1 and lines 3-4 of patent claim 5, respectively. Furthermore, with regard to claims 20, 28, 36, 44, it is inherent that image data attachments to e-mail messages are converted into a format for e-mail transmission, as such attachments cannot be transmitted via e-mail otherwise.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-20, 27, 28, 35, 36, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda.

Regarding claims 16-20, 27 and 28, Toyoda discloses an image data communication apparatus connected to an image data source and to a network, and transmitting an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus

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comprising: a panel section configured to input information regarding an identification of a user and a mail address of a user to the image data communication apparatus (operation panel 7); and a controller configured to set the information regarding the identification of the user and the mail address of the user, input by the panel section, into the mail message of the e-mail to which the image data is attached (column 15, lines 58-65; Fig. 17). The image data source comprises a scanner connected to the image data communication apparatus (scanner 6). The panel section comprises a personal computer connected to the image data communication apparatus, wherein the personal computer displays an HTML document for inputting the information regarding the identification of the user and the mail address of the user to the image data communication apparatus (e-mail computer 9A; Fig. 17). Toyoda further discloses a transmitter configured to transmit an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (e-mail transmitted through e-mail network 9B).

Toyoda does not disclose transmission of image data attached to an e-mail (claims 16 and 27), wherein the image data attached to the e-mail is converted into a format for e-mail transmission (claims 20 and 28). However, it is well known in the art that image data may be transmitted as an attachment to an e-mail message. It is common practice to transmit a document or a picture via e-mail by scanning the document or picture and attaching it to the e-mail, and in such a case the attached document is inherently converted into a format for e-mail transmission. By providing for the transmission of scanned image data as an attachment, a greater variety of image

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data can be transmitted for immediate reception at the receiving apparatus, and thus it would have been obvious to modify the teaching of Toyoda by providing a scanner for inputting image data so that the image data may be transmitted as an attachment to an e-mail message, as is well known in the art. It is inherent that image data attachments to e-mail messages are converted into a format for e-mail transmission, as such attachments cannot be transmitted via e-mail otherwise.

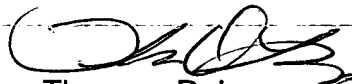
Claims 35, 36, 43 and 44 are method claims corresponding to above-rejected apparatus claims 16, 20, 27 and 28, respectively. The method steps are either disclosed in Toyoda, or would have been obvious to one of ordinary skill in the art, as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
September 27, 2005